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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/451,315	11/30/1999	DALE F. MCINTYRE	79909F-P	8863

1333 7590 06/24/2002

PATENT LEGAL STAFF
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EXAMINER

CARLSON, JEFFREY D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 06/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/451,315

Applicant(s)

MCINTYRE ET AL.

Examiner

Jeffrey D. Carlson

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) 35-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-43 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-34, drawn to a computer software product that locates and selects images and incorporates them into a game and provides a coupon for participation/winning, classified in class 705, subclass 14.
 - II. Claims 35-43, drawn to a system for managing a contest by plural sponsors, a host server tracking the number of times contests are provided, enabling sponsors to be charged accordingly, classified in class 705, subclass 400.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as: the software product can be used as a game/contest without a host server managing plural, sponsored games. See MPEP § 806.05(d).
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Frank Pincelli on 6/14/2002 a provisional election was made without traverse to prosecute the invention of group I, claims 1-34. Affirmation of this election must be made by applicant in replying to this Office action. Claims 35-43 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Specification

1. The abstract should focus on the elected software product/game, rather than the non-elected central host management of plural contest sponsors and their costs.

Claim Objections

1. Claims 3, 17, 18 and 33 are objected to because of the following informalities:

- Claims 3 and 18, --can-- should be inserted before "be verified".
- Claim 17 line 5, "media" should be replaced by --medium-- for consistency.
- Claim 33 line 2, "predetermine" should be replaced by --predetermined--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 32-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 32 lines 6-7, "which will be displayed" is unclear. It is uncertain if applicant is positively claiming such a displaying step.

- Claim 34 is unclear due to circular logic. An ad is displayed upon an action, yet the action selects and offers the ad??

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 1, 7, 8, 12 and 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Small (US 5791991).

Regarding claims 1, 12, 16, Small teaches software for a consumer product promotion and game system where images are incorporated into a matching game. The computer program that runs the game and the images used in the game are stored on a remote storage medium and when the program is loaded/run, the images are loaded and the game can be played by the consumer PC client [col 2 line 59 to col 3 line 21]. Participation in the game or winning the game results in automatic display of a message(s) [col 7 lines 26-58].

Regarding claims 7, 8, a product coupon is sent by the system to the user PC for printing [col 7 lines 51-58].

Regarding claims 14 and 15, the Bingo game described by Small is taken to be a square section puzzle.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2, 10, 11, 13, (14, 15 alternatively), 17, 22, 23, 25-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Small.

Regarding claims 2, 10, 17, 22, 23, 25, 27, 31-34, Small teaches interaction between the user and remote computers to be via web sites over the Internet, including providing hot links to web sites of participating manufacturers [col 5 lines 14-27]. Small also teaches prompting the user to select products or product categories and sending the requested data such as rebate data to the user. Small also suggests manufacturers sponsoring games and displaying ads for the user. It would have been obvious to one of ordinary skill at the time of the invention to have accomplished such requested promotional/advertising information delivery by way of the hot links mentioned by Small so that users can easily request and obtain such rebate information at the end of the promotional games and can select/click to learn more about various products and browse the promoting manufacturer's web site(s).

Regarding claim 11, 26, the program and images required by the system of Small are inherently stored on some type of accessible media. It would have been obvious to one of ordinary skill at the time of the invention to have stored such on a hard drive computer disk for speedy access and retrieval of the data.

Regarding claims 13-15, 28-30, Small provides a matching game with images covering "hidden" tiles. The computer randomly selects product groups and checks to see if the user's selected hidden tiles match. If so, the hidden tiles are revealed. The computer uses images or a mosaic of images to provide the covering tile texture/surfaces. The game is Bingo, not concentration. However, Small teaches that

other match games can be used instead [col 9 lines 12-15]. Official Notice is taken that the instantly described game of Concentration is a known game, where pairs of hidden cards/tiles are selected for matches to be revealed. It would have been obvious to one of ordinary skill at the time of the invention to have provided the promotional aspects of Small using the known game of Concentration rather than Bingo in order to provide a different game experience. Small provides a square section game/puzzle and it would have been obvious to one of ordinary skill at the time of the invention to have provided the known Concentration matrix as one which is square.

9. Claims 3-6 and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Small in view of Walker et al (US6203427). Walker et al also teaches computer games. Each game/contest includes a gameId, customerId and winning information. The winning information is also encrypted [fig 11b, col 9 lines 1-25]. It would have been obvious to one of ordinary skill at the time of the invention to have provided such game/contest identification means so that a winner requesting the prize must verify the authenticity of the winning contest by any well known means such as by phone or computer, so as to eliminate fraudulent collection of prizes. It would have been obvious to one of ordinary skill at the time of the invention to have encrypted the contest and winning information to further secure against fraud.

10. Claims 9 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Small in view of Barnett et al (US6336099). Small does not take steps to prevent a user

from printing multiple copies of coupons. Barnett et al also teaches electronic coupon distribution, but takes steps to ensure coupons can only be printed once [col 5 lines 47-62]. It would have been obvious to one of ordinary skill at the time of the invention to have prevented users from printing awarded coupons more than once, so as to eliminate fraud and to encourage playing multiple games, thus being subjected to more sponsorship promotion.

11. Claim 11 is alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Small in view of Forrest et al (US5679075). Forrest et al also teaches computer puzzle games. Forrest et al teaches that such puzzle games can be provided by a remote computer over the Internet, or alternately on CD ROMs distributed to playing users. It would have been obvious to one of ordinary skill at the time of the invention to have provided Small's promotional gaming on distributed CD ROMS so that server resources can be reduced.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Bell (US6061532) teaches a photofinisher that incorporated consumer images into image presentations and interactive game programs.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 703-308-3402. The examiner can normally be reached on Mon-Fri 8:30-6p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc
June 17, 2002